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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,720	12/28/2000	Isao Yagasaki	826.1658	6774
21171	7590	01/13/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/749,720	YAGASAKI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Igor Borissov	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 25 October 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

In view of the appeal brief filed on 10/25/2005 PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Blinn et al. (US 5,999,914).

Blinn et al. (Blinn) teaches a promotion method, system and computer-readable recording medium having instructions embedded therein for performing said method, comprising:

Claim 4. Said system, comprising:

a storing device storing a plurality of membership qualification tables of a plurality of services in a membership qualification system, each of the plurality of membership qualification tables including qualification criterion information for qualifying membership of a corresponding service (Fig. 16), and defining a prescribed service of which a user ought to be a member to have a membership qualification for the corresponding service (Fig. 17), and identification information of a first service of the plurality of services being included by qualification criterion information for qualifying membership of a second service of the plurality of services for indicating the prescribed service (C. 22, L. 65 – C. 23, L. 15);

a receiving device receiving information of a user for whom membership qualification is performed (C. 7, L. 37-49);

a first determining device determining, in response to the information of the user, whether the user is utilizing the first service when the user wants to become a member of the second service (C. 2, L. 21-23; C. 11, L. 46-47, 55-56);

a second determining device determining that the user has a membership qualification for the second service by referring to the membership qualification table of the second service and checking that the identification information of the first service is included in the qualification criterion information of the second service when the user is utilizing the first service (C. 8, L. 18, 22-23; C. 18, L. 27-48).

Claim 1. Said system, wherein said storing device stores a plurality of service tables of the services, each of which includes a membership condition of a corresponding service (Figs. 13-16), wherein said receiving device receives from the user a request to present an available membership service for the user (C. 17, L. 3-7), and wherein said processing system further comprises:

a selecting device extracting, from among the plurality of service tables, a first membership condition from a service table of a current service of which the user has become a member (C. 18, L. 27-48), and a second membership condition from at least one service table of at least one other service of which the user has not become a member in response to the request, comparing the first and second membership conditions, and selecting an eligible service of which the user can become a member, and a presenting device presenting information to the user about the eligible service of which the user can become a member (C. 22, L. 65 – C. 23, L. 15).

Claim 2. Said system, wherein when the user is a member of at least two services, said selecting device totals membership conditions of the at least two services using an AND operation and compares a totaled membership condition with the second membership condition of the service of which the user has not become a member (evaluating eligibility of the shopper by comparing shopper's criteria against promotion table criteria) (C. 18, L. 27-48).

Claim 3. Said system, comprising a registering device registering common certificate information (membership condition) that is in common with the at least two services, wherein said receiving device receives certificate information (identity) of the user, and wherein, when the certificate information of the user corresponds to the common certificate information (when it is confirmed that the shopper is a member), said selecting device obtains the membership conditions of the at least two services based on the certificate information of the user (confirming eligibility of a shopper for a membership discount) (C. 18, L. 27-48; C. 22, L. 65 – C. 23, L. 15).

Claim 5. Said system, comprising a registering device registering certificate information for a service that the user is utilizing, wherein said receiving device receives identification information of the certificate information of the user, and wherein when the identification information corresponds to the registered certificate information, said first determining device obtains information about the service that the user is utilizing based

on the identification information and determines whether or not the user is utilizing the first service (confirming eligibility of a shopper for a membership discount) (C. 18, L. 27-48; C. 22, L. 65 – C. 23, L. 15).

**Claim 6. Said system, comprising:**

a storing device storing a plurality of service tables of a plurality of existing services in a membership qualification system, each of the plurality of service tables including a membership condition of a corresponding service of the plurality of existing services (C. 22, L. 65 – C. 23, L. 15);

a designating device designating a new membership condition (Fig. 12A);

a simulating device comparing each membership condition of the service tables of the existing services with the new membership condition, adding information of users who are members of an existing service to a member count table when the new membership condition satisfies an old membership condition of the existing service, and obtaining new member information about a number of users who can become members of another service corresponding to the new membership condition by counting a number of pieces of information contained in the member count table (evaluating eligibility of the shopper by comparing shopper's criteria against promotion table criteria) (C. 18, L. 27-48; C. 22, L. 65 – C. 23, L. 15); and

an output device outputting the new member information (Fig. 12A).

**Claim 7. Said system, comprising:**

a registering device registering a plurality of pieces of certificate information of the plurality of users who are utilizing the existing services (identifying are shoppers members), wherein said simulating device adds certificate information of the users who are the members of the existing service to the member count table when the new membership condition satisfies the old membership condition of the existing service, counts a number of the pieces of certificate information contained in the member count table, and obtains the number of users who can become the members of the other

service corresponding to the new membership condition (evaluating eligibility of the shopper by comparing shopper's criteria against promotion table criteria) (C. 18, L. 27-48; C. 22, L. 65 – C. 23, L. 15).

Claim 9. Said computer-readable recording medium on which at least one program for a computer is recorded, said program comprising:

receiving information of a user for whom membership qualification is performed (C. 38, L. 9-10);

determining whether the user is utilizing a first service in a membership qualification system using membership qualification tables of services, each of the membership qualification tables including qualification criterion information for qualifying membership of a corresponding service and defining a prescribed service of which a user ought to be a member to have a membership qualification for the corresponding service, when the user wants to become a member of a second service in the membership qualification system based on the identification information of the first service included in the qualification criterion information for qualifying membership of the second service (C. 22, L. 65 – C. 23, L. 15); and

determining that the user has a membership qualification for the second service by referring to the membership qualification table of the second service and checking that the identification information of the first service is included in the qualification criterion information of the second service when the user is utilizing the first service (C. 18, L. 27-48).

Claim 8. Said system, wherein by said receiving the computer receives from the user a request to present an available membership service for the user, and wherein said method further comprises:

extracting, in response to the request, from among a plurality of service tables of the services, each of which includes a first membership condition of a current service of which the user has become a member, and a second membership condition from at

least one service table of at least one other service of which the user has not become a member (C. 18, L. 27-48);

comparing the first and second membership conditions (C. 18, L. 27-48);

selecting an eligible service of which the user can become a member, and presenting information to the user about the eligible service of which the user can become a member (C. 22, L. 65 – C. 23, L. 15).

Claim 10. Said computer-readable recording medium on which at least one program for a computer is recorded, said at least one program causing the computer to perform:

storing service tables of existing services, each of the service tables including a membership condition of a corresponding service of the existing services (Figs. 13-16;

designating a new membership condition (C. 22, L. 65 – C. 23, L. 15);

comparing each membership condition of the service tables of the existing services in a membership qualification system with the new membership condition (C. 18, L. 27-48);

adding information of users who are members of an existing service to a member count table when the new membership condition satisfies an old membership condition of the existing service (C. 18, L. 27-48);

obtaining new member information about a number of users who can become members of another service corresponding to the new membership condition by counting a number of pieces of information contained in the member count table (C. 11, L. 46-47, 55-56);

outputting the new member information (Fig. 12A).

Claim 11. Said method as set forth in claim 12, wherein said storing includes

storing a plurality of service tables of the services, each of the service tables including a membership condition of a corresponding service (Fig. 13-16), wherein said receiving includes receiving from the user a request to present an available membership service for the user, wherein said processing method further comprises:

extracting, in response to the request, from among the plurality of service tables, a first membership condition from a service table of a current service of which the user has become a member and a second membership condition from at least one service table of at least one other service of which the user has not become a member (C. 18, L. 27-48);

comparing the first and second membership conditions (C. 18, L. 27-48);

selecting an eligible service of which the user can become a member, and wherein said displaying includes displaying information about the eligible service of which the user can become a member on the screen (Fig. 17).

Claim 12. Said method, comprising:

referencing the qualification criterion information for qualifying membership of a first service in a membership qualification system using membership qualification tables of services, each of the membership qualification tables including qualification criterion information for qualifying membership of a corresponding service and defining a prescribed service of which a user ought to be a member to have a membership qualification for the corresponding service, when a user wants to become a member of the first service (C. 22, L. 65 – C. 23, L. 15);

receiving information of a user for whom membership qualification is performed determining, in response to the information of the user, whether the user is utilizing a second service in the membership qualification system based on the identification information of the second service included in the qualification criterion information (C. 11, L. 46-47, 55-56);

determining that the user has a membership qualification for the first service by referring to the membership qualification table of the first service and checking that the identification information of the second service is included in the qualification criterion information of the first service when the user is utilizing the second service (C. 18, L. 27-48);

displaying a qualification result on a screen (Fig. 17).

Claim 13. Said method, comprising:

storing service tables of existing services, each of the service tables including a membership condition of a corresponding service of the existing services (Figs. 13-17);

designating a new membership condition (Fig. 12A; C. 38, C. 9-10);

comparing each membership condition of the service tables of the existing services in a membership qualification system with the new membership condition (C. 18, L. 27-48);

adding information of users who are members of an existing service to a member count table when the new membership condition satisfies an old membership condition of the existing service (C. 18, L. 27-48);

obtaining new member information of a number of users that can become members of another service corresponding to the new membership condition by counting a number of pieces of information contained in the member count table (C. 11, L. 46-47, 55-56);

displaying the new member information on a screen (Fig. 12A; 17).

Claim 15. Said system, comprising:

storing means for storing membership qualification tables of services in a membership qualification system, each of the membership qualification tables including qualification criterion information for qualifying membership of a corresponding service and defining a prescribed service of which a user ought to be a member to have a membership qualification for the corresponding service, and identification information of a first service included in the qualification criterion information for qualifying membership of a second service for indicating the prescribed service (Figs. 13-17);

a receiving device receiving information of a user for whom membership qualification is performed (C. 7, L. 37-49);

first determining means for determining, in response to the information of the user, whether the user is utilizing the first service when the user wants to become a member of the second service (C. 2, L. 21-23; C. 11, L. 46-47, 55-56);

second determining means for determining that the user has a membership qualification for the second service by referring to the membership qualification table of the second service and checking that the identification information of the first service is included in the qualification criterion information of the second service when the user is utilizing the first service (C. 8, L. 18, 22-23; C. 18, L. 27-48).

Claim 14. Said system as set forth in claim 15, wherein said storing means stores a plurality of service tables of the services, each of which includes a membership condition of a corresponding service (Figs. 13-17), wherein said receiving means receives from the user a request to present an available membership service for the user (C. 7, L. 37-49), and wherein said processing system further comprises:

selecting means for extracting, from among the plurality of service tables, a first membership condition from a service table of a current service of which the user has become a member and a second membership condition from at least one service table of at least one other service of which the user has not become a member in response to the request, comparing the first and second membership conditions, and selecting an eligible service of which the user can become a member (C. 18, L. 27-48);

presenting means for presenting information to the user about the eligible service of which the user can become a member (C. 7, L. 37-49).

Claim 16. Said system, comprising:

storing means for storing service tables of existing services in a membership qualification system, each of the service tables including a membership condition of a corresponding service of the existing services (Figs. 13-17);

designating means for designating a new membership condition (C. 38, L. 9-10);

simulating means for comparing each membership condition of the service tables of the existing services with the new membership condition, adding information of users who are members of an existing service to a member count table when the new membership condition satisfies an old membership condition of the existing service and obtaining new member information about a number of users who can become members

of another service corresponding to the new membership condition by counting a number of pieces of information contained in the member count table (C. 18, L. 27-48); output means for outputting the new member information (Fig. 12A).

Claim 18. Said computer accessible transfer medium supplying a program to a computer, said program causing the computer to perform:

receiving information of a user for whom membership qualification is performed (C. 7, L. 37-49);

determining, in response to the information of the user, whether the user is utilizing a first service in a membership qualification system using membership qualification tables of services, each of the membership qualification tables including qualification criterion information for qualifying membership of a corresponding service and defining a prescribed service of which a user ought to be a member to have a membership qualification for the corresponding service, when the user wants to become a member of a second service in the membership qualification system based on identification information of the first service included in qualification criterion information for qualifying membership of the second service (C. 22, L. 65 – C. 23, L. 15);

determining that the user has a membership qualification for the second service by referring to the membership qualification table of the second service and checking that the identification information of the first service is included in the qualification criterion information of the second service when the user is utilizing the first service (C. 18, L. 27-48).

Claim 17. Said computer accessible transfer medium as set forth in claim 18, said program further causing the computer to perform:

extracting, from a plurality of service tables of the services, a first membership condition from a service table of a current service in a membership qualification system of which a user has become a member and a second membership condition from at least one service table of at least one other service in the membership qualification

system of which the user has not become a member in response to the request (C. 18, L. 27-48);

comparing the first and second membership conditions (C. 18, L. 27-48);

selecting an eligible service of which the user can become a member (C. 38, L. 9-10);

presenting information to the user about the eligible service of which the user can become a member (C. 7, L. 37-49).

Claim 19. Said computer accessible transfer medium supplying a program to a computer, said program causing the computer to perform:

storing service tables of existing services, each of the service tables including a membership condition of a corresponding service of the existing services (Figs. 13-17);

designating a new membership condition (C. 38, L. 9-10);

comparing each membership condition of the service tables of the existing services in a membership qualification system with the new membership condition (C. 18, L. 27-48);

adding information of users who are members of an existing service to a member count table when the new membership condition satisfies an old membership condition of the existing service (C. 18, L. 27-48);

obtaining new member information about a number of users who can become members of another service corresponding to the new membership condition by counting a number of pieces of information contained in the member count table (C. 18, L. 27-48);

outputting the new member information (Fig. 12A).

### ***Response to Arguments***

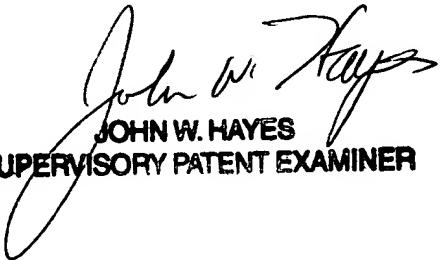
Applicant's arguments with respect to Claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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01/05/2006



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